

REMARKS

Species A includes claims 22, 25, 26 and 32, which ultimately depend from claim 17. The Examiner admits claims 17-21, 27-29 and 37 are generic, and identifies claims 24, 31, 33 and 38 as Species B. The Examiner also has commented on lack of clarity in claims 23 and 30 but has not included them as generic claims or as part of Species A or Species B.

Applicants traverse this restriction because the Examiner has not stated a reason for restriction and the restriction is otherwise improper.

Failure to State Reasons for Restriction

An Examiner must state the particular reasons for holding that the inventions as claimed are either independent or distinct. MPEP § 816. “A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.” *Id.* In her restriction requirement, the Examiner asserts two species exist but has not identified the reasons for her assertion. A mere statement of conclusion is provided. This is error. Applicants request either a statement of reasons for the restriction or withdrawal of the restriction.

Propriety of Restriction

“[T]he Commissioner may require restriction if two or more ‘independent and distinct’ inventions are claimed in one application.” MPEP § 802.01. Independent means, “there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect.” *Id.* If “the classification [of the two or more subjects] is the same and the field of search is the same and there is no

clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” Id. § 808.02.

The present application includes four independent claims, 17, 33, 37 and 38. Claims 18-32 depend from independent claim 17. Claims 34-36 depend from independent claim 33. The Examiner considers claims 24 and 31 to be distinct inventions from claim 17 despite their dependency from claim 17. Applicants do not believe restriction of dependent claims is proper. Clearly, dependent claims 24 and 31 are connected “in design, operation, or effect” with their independent claim. Claims 24 and 31 require no additional search and no reason exists for dividing these claims from their independent claim. Applicants submit restriction of claims 24 and 31 from claim 17 is improper.

The Examiner believes claims 33 and 38 teach independent and distinct inventions from that of claim 17. Claim 17 describes a beam shell comprising shell cladding forming a hollow body defining a recess for receiving a strength member. Claims 33 and 38 include the elements of claim 17 plus at least a tubular side rail extension. Clearly, claims 17, 33 and 38 are similar in design, operation and effect and should not be considered separate species for restriction purposes.

Applicants further submit that a search of claim 17 would be sufficient also for claims 33 and 38. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Id. 803 (emphasis added). Even if the Examiner could explain how claims 17, 33 and 38 are directed to different species, the

Examiner would bear no extra burden for search or examination of the separate species.

Patent Office procedure compels the Examiner to remove her restriction requirement.

Claims 23 and 30

The Examiner believes claims 23 and 30 are unclear because a bumper skin and fastener, respectively, are not shown in any embodiment.

Claim 23 uses the term “bumper skin.” The specification repeatedly references a “bumper skin” and the relationship it has with the shell. One skilled in the art would readily understand the meaning of the term in light of the specification. Applicants submit claim 23 is not unclear.

Claim 30 uses the term, “fastener,” instead of the term, “fastening means,” which is used in the specification. Literal translation of the foreign priority document would include the latter term. Means-for language is broadly interpreted in foreign patent documents but is narrowly construed by US courts. Substitution in the claims of “fastener” for “fastening means” simply preserves the original intent of the Applicants. If necessary, Applicants will submit a substitute specification with the term, “fastener.”

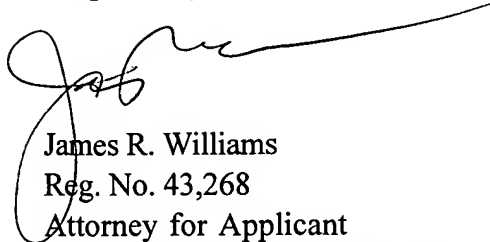
In summary, Applicant believes the restriction requirement is improper because (a) the Examiner failed to state reasons for her restriction, (b) dependent claims 24 and 31 cannot be independent and distinct from their independent claim, and (c) procedure requires the Examiner to examine the all claims on their merits when examination can be made without serious burden. Claims 23 and 30 are not unclear to one skilled in the art, who has read the specification. Applicant requests consideration and withdrawal of the

restriction requirement and cancellation of the Examiner's objection based on lack of clarity.

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